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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Serial No.: 09/995,158  
 Filing Date: November 27, 2001  
 Applicant(s): BANK, Lawrence C.  
 Title: STRUCTURAL REINFORCEMENT USING COMPOSITE STRIPS

Group Art Unit: 1774  
 Examiner: Thompson, Camie S.  
 Atty. Docket: 09820.176

FAX RECEIVED  
 AUG 07 2003  
 GROUP 1700

**PETITION UNDER 37 CFR §1.144  
 FROM REQUIREMENT FOR RESTRICTION**

Technology Center Director, Group 1774  
 Mail Stop Non-Fee Amendment  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

OFFICE

This petition is filed in the above-noted application to withdraw the restriction requirement made final in the July 17, 2003 Office Action.

As per MPEP 1002.02(c)(2), it is understood that this Petition is to be decided by the Technology Director for Group Art Unit 1774. If this understanding is incorrect, please forward to the Office of Petitions or the other responsible entity.

1. **Petition Fee (37 CFR §1.17(h)):** No fee is required for this Petition.
2. **Timing of Petition (37 CFR §1.181(f)):** This Petition is filed within two months of the Office Action wherein the requirement for restriction was made final.
3. **Prior Request for Reconsideration (37 CFR §§1.144, 1.181(c)):** The Applicant requested reconsideration in a Request for Reconsideration submitted to the Examiner on April

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| I certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office as follows: |                |        |                |
| 1774   | (703) 872-9310 | 8-5-03 | Maureen Layton |
| Group Art Unit   | Facsimile No.  | Date   | Signature      |

24, 2003, a copy of which is attached. The request was denied, and the requirement for restriction made final, in the Office Action of July 17, 2003.

**4. Statement of Facts (37 CFR §1.181(b)):** The facts are as follows.

The Application as filed contained the following independent claims:

1. An elongated structural reinforcing strip comprising:
  - a. elongated continuous parallel fibers having lengths extending along the length of the strip;
  - b. nondirectional fibers distributed transversely across the strip; and
  - c. a polymer matrix affixing the parallel and nondirectional fibers.wherein the strip is affixed to the surface of a structure by several fasteners inserted through the strip and into the structure.
  
14. A method of reinforcing a structure comprising the steps of:
  - a. providing an elongated structural reinforcing strip which includes:
    - i. elongated continuous parallel fibers having lengths extending along the length of the strip;
    - ii. nondirectional fibers distributed transversely across the strip; and
    - iii. a polymer matrix affixing the parallel and nondirectional fibers;
  - b. placing the strip upon a surface of the structure;
  - c. inserting several fasteners through the strip and into the structure.
  
19. A reinforced structure comprising:
  - a. an elongated strip having a polymer matrix with embedded fibers, the fibers including:
    - i. elongated continuous fibers having parallel lengths extending along the length of the strip, and
    - ii. nondirectional fibers; and
  - b. a series of fasteners extending through the strip and into the surface of the structure.

The Examiner required restriction between the following groups on the following bases (see page 2 of April 9, 2003 Office Action):

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13 and 19-20, drawn to a strip and reinforced structure, classified in class 428, subclass 114.
  - II. Claims 14-18, drawn to a method of reinforcing a structure, classified in class 29, subclass 897.35.

- The inventions are distinct, each from the other because of the following reasons:
2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, a composite material wherein the fibers are metallic fibers can make a reinforced structure.
  3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The Applicant requested reconsideration of the requirement on the following bases (see pages 2-4 of the April 24, 2003 Request for Reconsideration):

2. Traverse: Bases for Restriction are Not Met

Two conditions must both be met before a proper requirement for restriction can be made (MPEP 803):

- (1) The inventions must be independent or distinct as claimed; *and*
- (2) There must be a serious burden on the Examiner if restriction is not required.

As discussed below in sections 2.a and 2.b, it is submitted that neither condition is met for the above-noted groups.

2.a. First Criterion for Restriction: Serious Burden on the Examiner

As discussed by MPEP 803 and 808.02, a prima facie showing of a serious burden on the Examiner may be established by the Examiner's showing of a different field of search, separate classification, or separate status in the art. With respect to separate classification or separate status in the art, it is important to note that these do not automatically provide evidence of a serious burden; rather, they only do so where they demonstrate that a different field of search is indeed present (MPEP 808.02).

What constitutes a "different field of search" is defined in MPEP 808.02 and MPEP 904-904.03. MPEP 808.02 states that a different field of search exists "where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists." MPEP 904-904.03 then provide guidelines for the field of the search to be performed prior to examination of an application. It is noted that the art must be searched with respect to variant embodiments (MPEP 904.01(a)), patentable equivalents (MPEP 904.01(b)), and analogous art (MPEP 904.01(c)). MPEP 904.02 further notes that the Examiner's field of search should "cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed" (as does MPEP 904.02(a)), and MPEP 904.03 states that the search must be "commensurate with the limitations appearing in the most detailed claims in the case."

It is evident from the principles set forth in the aforementioned sections of the MPEP that there is no different field of search for Groups I and II, and that no serious burden to the Examiner would arise if all claims are searched and examined. Kindly carefully review the elements/limitations recited in claims 1, 14, and 19; it is seen that there is substantial overlap. In accordance with MPEP 904-904.03, the field of search for both Groups should be the same since each Group is analogous art to the

other in accordance with the principles of *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986) and *In re Wood*, 202 USPQ 171, 174 (CCPA 1979). Since there is no serious burden, it is submitted that the requirement for restriction should be withdrawn. As noted by MPEP 803, if the search and examination of an application can be made without serious burden, the Examiner must examine the application on the merits even though it includes claims to distinct or independent inventions.

**2.b. Second Criterion for Restriction: Distinct or Independent Inventions**

The Examiner contends that the inventions of Groups I and II are distinct under MPEP 806.05(f) as a process of making and a product made. This section provides:

A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make other and different products; or (B) that the product *as claimed* can be made by another and materially different process.

Here, the Examiner states that "a composite material wherein the fibers are metallic fibers can make a reinforced structure," which appears to be an argument that the method of Group II can be used to make a product materially different from the one of Group I. However, the stated rationale is either inapposite or misunderstood: *neither claim 1, nor claim 14, nor claim 19, are limited to metallic or nonmetallic fibers*, so it is simply not seen how/why metallic fibers are relevant. Also, observe the method of claim 14 versus the product of claim 19: the process as claimed cannot be used to make materially different products (and the product as claimed cannot be made by a materially different process). Since a showing of distinctness has not been made, the restriction requirement should be withdrawn.

**3. Traverse: Claims 1, 14, and 19 are Linked**

As per MPEP 809.03, claims may be so linked as to make them inseparable. Note that claims 1 and 14 are linked (not distinct) as per MPEP 806.05(h), and claims 14 and 19 are also linked (not distinct) as per MPEP 806.05(f) – and claims 1 and 19, both being in Group I, are inherently linked. In other words, each independent claim links the other two. Again, kindly review and compare claims 1, 14, and 19 and the limitations recited therein, and the relationship is apparent.

The restriction requirement was then made final on the following bases (see page 2 of July 17, 2003 Office Action):

2. Applicant argues the restriction requirement. Group I, claims 1-13 and 19-20 are drawn to an elongated structural reinforcing strip and Group II, claims 14-18 are drawn to the method of reinforcing a structure. A different method can be used to reinforce a structure. For example, the reinforcing strip can be placed on a surface that already has fasteners. Additionally, the method for reinforcing a structure and a reinforcing strip require different search strategies. The requirement for restriction is still deemed proper and therefore is made FINAL.

Withdrawal of the restriction requirement is requested for the reasons noted in the Request for Reconsideration. The allegedly different field of search asserted by the Examiner does not seem appropriate for the matter of Group II (since class 29, subclass 897.35 has a class definition of "metal working, method of mechanical manufacture, structural member making, beam or girder," which seems inapposite to the claimed method), and the alleged basis for distinctness under MPEP 806.05(f) also does not seem appropriate, nor supportable in view of the inventions as claimed. Moreover, MPEP 821.01 states that when a restriction requirement is made final, "the examiner should reply to the reasons or arguments advanced by applicant in the traverse." This has not been done; the points raised in the Request for Reconsideration are not addressed. Additionally, the basis asserted for making the requirement final:

A different method can be used to reinforce a structure. For example, the reinforcing strip can be placed on a surface that already has fasteners.

does not appear to be a tenable or relevant way of making the product of Group I *as claimed*, as required by MPEP 806.05(f): even if the reinforcing strip is "placed on a surface that already has fasteners", fastening (as per Group II/claim 14) is still required to make the product *as claimed* in Group I/claims 1 and 19.

As per 37 CFR §1.181(b), any facts requiring proof are set out in the form of declarations or exhibits accompanying this Petition.

5. **Action Requested (37 CFR §1.181(b)):** It is requested that the restriction requirement be withdrawn, and that any subsequent actions address all claims. If this relief is denied, it is then requested that the basis for the restriction be more fully explained and that the Applicant's traversal be fully addressed, as required by MPEP 821.01.

**In Closing**

If any questions regarding this petition or the application arise, please contact the undersigned attorney. Telephone calls are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,

**ATTACHMENTS:**

- Page 2, April 9, 2003 Office Action
- April 24, 2003 Response
- Page 2, July 17, 2003 Office Action

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**Craig A. Fieschko, Reg. No. 39,668**  
**DEWITT ROSS & STEVENS, S.C.**  
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8000 Excelsior Drive, Suite 401  
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Application/Control Number: 09/995,158  
Art Unit: 1774

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**DETAILED ACTION***Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13 and 19-20, drawn to a strip and reinforced structure, classified in class 428, subclass 114.
  - II. Claims 14-18, drawn to a method of reinforcing a structure, classified in class 29, subclass 897.35.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, a composite material wherein the fibers are metallic fibers can make a reinforced structure.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. A telephone call was made to Craig A. Fieschko on February 19, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

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PATENT

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 Title: STRUCTURAL REINFORCEMENT USING COMPOSITE STRIPS

Group Art Unit: 1774  
 Examiner: Thompson, Camie S.  
 Atty. Docket: 09820.176

REQUEST FOR RECONSIDERATION OF  
 REQUIREMENT FOR RESTRICTION  
 (37 CFR §1.143)

GROUP 1700

AUG 07 2003

FAX RECEIVED

Box: Non-Fee Amendment  
 Assistant Commissioner for Patents  
 Washington, D.C. 20231

To the Commissioner: In Response to the Office Action of April 9, 2003, reconsideration of the restriction requirement is requested in light of the following comments.

**I. Summary of Restriction Requirement and Provisional Election**

The Examiner contends that the inventions claimed in the following groups are patentably distinct and require restriction to a single group:

*Group I:* The apparatus of claims 1-13 and 19-20, allegedly classified in class 428, subclass 114 (class definition: stock material or miscellaneous articles, structurally defined web or sheet, including grain, strips, or filamentary elements in different layers or components parallel).

*Group II:* The apparatus of claims 14-18, allegedly classified in class 29, subclass 897.35 (class definition: metal working, method of mechanical manufacture, structural member making, beam or girder).<sup>1</sup>

<sup>1</sup> It is questioned why this class is believed to be proper. Note that claim 14 is in no way restricted to "metal working," nor to "beams and girders."

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| Group Art Unit   | Facsimile No.  | Date    | Signature     |



Group I (claims 1-13 and 19-20) is provisionally elected for further examination. However, it is submitted that both groups should be maintained for examination in light of the traversals set forth below.

**2. Traverse: Bases for Restriction are Not Met**

Two conditions must both be met before a proper requirement for restriction can be made (MPEP 803):

- (1) The inventions must be independent or distinct as claimed; *and*
- (2) There must be a serious burden on the Examiner if restriction is not required.

As discussed below in sections 2.a and 2.b, it is submitted that neither condition is met for the above-noted groups.

**2.a. First Criterion for Restriction: Serious Burden on the Examiner**

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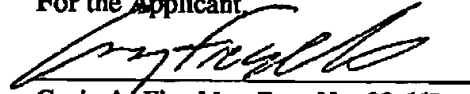
**3. Traverse: Claims 1, 14, and 19 are Linked**

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**4. In Closing**

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant



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OFFICIAL

Application/Control Number: 09/995,158  
Art Unit: 1774

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#### DETAILED ACTION

1. Applicant's election of Group I, claims 1-13 and 19-20 with traverse are acknowledged.
2. Applicant argues the restriction requirement. Group I, claims 1-13 and 19-20 are drawn to an elongated structural reinforcing strip and Group II, claims 14-18 are drawn to the method of reinforcing a structure. A different method can be used to reinforce a structure. For example, the reinforcing strip can be placed on a surface that already has fasteners. Additionally, the method for reinforcing a structure and a reinforcing strip require different search strategies. The requirement for restriction is still deemed proper and therefore is made FINAL.

#### *Claim Rejections - 35 USC § 112*

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear in claim 1 whether or not the structural reinforcing strip comprises of a, b, c and several fasteners or a structural reinforcing strip comprising a, b, c and is attached to a surface that has fasteners. It is unclear as to whether or not the "wherein" clause in claim 1 is for intended use of the strip.